

REMARKS

In the Restriction Requirement mailed 19 December 2008, the Examiner required election of one of the following allegedly distinct inventions.

Group I: Claims 1-16, 22, and 23, drawn to a fluorocarbon emulsion; and
Group II: Claims 17-21, drawn to a method of producing a fluorocarbon emulsion.

The Examiner further indicated the following species:

In Group I, for claims 1-16, 22, 23 of single or group of related compounds are required, for example, [perfluorodecaline] or related compounds or [perfluoro-1-propyl-3,4-dimethylpyrrolidone] or related compounds, with the explanation and exact definition of all the components in the emulsion.

Before responding to the Restriction Requirement, the undersigned called the Examiner to discuss the species requirement. The undersigned asked for clarification of what exactly the species were, and more particularly what were the alleged “perfluorodecaline or related compounds?” The Examiner said that Applicants needed to elect either perfluorodecaline or perfluorooctylbromide in Claim 1. The undersigned explained that Claim 1 recites a composition of both of these compounds and they are thus not species. The Examiner would not or could not further identify the species in further detail and placed the burden on Applicants to identify the species since it was “their invention.” The undersigned was not confident of the Examiner’s understanding of the invention of Claim 1 as an emulsion of the recited compounds. The Examiner agreed that clarifying the

Serial No.: 10/591,411

claimed invention may assist in clarifying the Restriction Requirement. Applicants responded with replacing Claim 1 with new Claims 25 and 26, and made a provisional election based upon the best understanding of the Examiner's requirement.

The Examiner called the undersigned on 18 March 2009 and requested that the undersigned make a species election. The undersigned noted the earlier conversation and explained that a species election would be made upon the actual identification of a proper species by the Examiner. The Examiner again could not or would not identify the alleged species and placed the burden on Applicants to identify the species. As the Examiner had not yet reviewed Applicants' written traversal in detail, the undersigned requested the Examiner review the remarks and call back with an identification of the species.

On 01 May 2009, the undersigned received a voice mail message from the Examiner requesting a species election and noting "species" in Claims 24, 25, 5 and 6. The undersigned called the Examiner and again asked for clarification of the alleged species, particularly as Claims 24 and 25 are generic and Claim 25 recites a combination of fluorocarbons. Claim 5 was also noted as generic to Claim 6, and these claims are not mutually exclusive species. The Examiner could not explain the species, and the undersigned was hesitant to make an election as it was unclear what claims would be withdrawn as a result. The undersigned suggested a further

Serial No.: 10/591,411

interview with the Examiner and his supervisor in an attempt to mitigate the continuing confusion. Applicants then received the Office Communication.

In response to the Office Communication, the undersigned has reviewed each claim for possible species of fluorocarbon compounds. The undersigned has made a good faith effort and has identified that the only mutually exclusive fluorocarbon species are in Claim 5 and Claim 22.

Applicants hereby elect, with continued traverse, the species of Claim 5. Claims 5 and 6 read on the elected species, and Claims 2-4, 7-16, and 23-25 are generic. Claims 2-16 and 23-25 read on the elected invention. As previously noted, Claims 17-21 should not be withdrawn under PCT Rules 13.1 and 13.2, and all claims but Claim 22 should be considered on the merits.

The species restriction in the Office Action is simply a mere statement that there are species, and no reasoning is provided as to why the alleged species are not linked as to form a single general inventive concept. Therefore, the species restriction is still improper.

If the Examiner does not agree with this election, the Examiner should clearly identify each of the disclosed species under Rule 13.1, to which claims are to be restricted, as required by MPEP 809.02(a).

Prior Comments Traversing the Restriction Requirement

For the Examiner's convenience, the following remarks previously entered for traversing the Restriction Requirement between Groups I and II are repeated below.

According to PCT Rule 13.2 the requirement of unity of invention referred to in Rule 13.1 "shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features," which are "those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." 37 CFR 1.475(b)(2) states that a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to a product and a process for manufacturing of said product. This is the case in Applicants' claims, which are drawn to a fluorocarbon emulsion and a method of making the fluoropolymer emulsion.

As best understood from the Office Action, the Examiner's position is that because perfluorooctylbromide is known for use as a blood substitute, the "compounds of the claims" lack any special structural element qualifying as special technical feature that defines a contribution over the prior art. However, the Office Action does not properly analyze the invention, as Applicants' claimed invention is an emulsion containing several components; the invention is not merely the use of perfluorooctylbromide. This is but one element recited in claims of the subject

Serial No.: 10/591,411

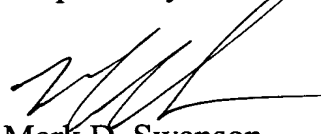
Patent Application. Applicants respectfully assert the Restriction Requirement should be withdrawn because of this incomplete, and thus incorrect, consideration of the claimed invention.

Applicants note that Claims 1-21 were found to have unity of invention, as well as novelty and inventive step, by the International Searching Authority.

Conclusion

Applicants sincerely believe that this U.S. Patent Application is now in condition for examination and prosecution before the U.S. Patent and Trademark Office. Applicants intend to be fully responsive, and request a telephone interview if any further issue remains.

Respectfully submitted,



Mark D. Swanson
Registration No. 48,498

Pauley Petersen & Erickson
2800 West Higgins Road; Suite 365
Hoffman Estates, Illinois 60169
TEL (847) 490-1400
FAX (847) 490-1403